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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/763,686   | 01/23/2004  | Motoharu Tanizawa    | 5000-5141           | 9107             |
| 27123  | 7590        | 06/16/2005           | EXAMINER            |                  |
| MORGAN & FINNEGAN, L.L.P.<br>3 WORLD FINANCIAL CENTER<br>NEW YORK, NY 10281-2101 |             |                      | IP, SIKYIN          |                  |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             |                      |                     | 1742             |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 10/763,686             | TANIZAWA ET AL.     |
| Examiner                     | Art Unit<br>Sikyin Ip  | 1742                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 3/23/05; 5/13/05.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1,3,4 and 6-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,3,4 and 6-17 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/13/05.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Double Patenting***

The Double Patenting rejection has been withdrawn in view of the terminal disclaimer.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0990710 (PTO-1449, page 7, Table 1, comparative example 2).

Claims 4, 7-8, 10-11, 13, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0990710 (PTO-1449, [0003] to [0004] and page 7, Table 1, comparative example 2).

The claimed composition and method read on intermediate cast product of cited reference.

### ***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application

indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c ) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, and 6-17 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4997622 to Regazzoni et al (col. 1, lines 5-35 and col. 8, lines 45-66) or USP 5073207 to Faure et al (PTO-1449, col. 1, line 40 to col. 2, line 5 and Col. 4, Table 1, Test No. 1).

Cited references disclose(s) the features including the claimed Mg based alloy compositions. Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. *In re Gyurik*, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See *In re May*, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and *In re Hoch*, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference

because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123. With respect to the instant claim 3 that the ratio is overlapped by the cited references because the claimed proportions of Al and Ca have been disclosed.

With respect to the Ca to Al ratio that the claimed proportions of Ca and Al are overlapped by said elements of cited references. Therefore, the ratio would have been overlapped. Furthermore, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

With respect to the properties as recited in instant claims 4 and 13 which are material properties. Thus, it would have been inherently possessed by the material of cited references. The product by process steps in instant claims 7 and 15 are no more than essential steps the required to form an alloy. Moreover, the invention defined in a product-by-process claim is a product, not a process. *In re Bridgeford*, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113.

#### ***Response to Arguments***

Applicant's arguments filed March 23, 2005 have been fully considered but they are not persuasive.

Applicants' argument in instant remarks is noted. But, it is well settled that the examples of the cited reference are given by way of illustration and not by way of limitation. *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965), *In re Boe*, 148 USPQ 507 (CCPA 1966), and *In re Snow*, 176 USPQ 328. The teaching of a reference is not limited to preferred embodiments. All disclosures of prior art, including unpreferred embodiments, must be considered in determining obviousness. See *In re Boe*, 148 USPQ 507, 510 (CCPA 1966), *Ex parte Thumm* 132 USPQ 66, 68, and *In re Siebentritt*, 152 USPQ 618. Moreover, under 35 USC § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. *In re Lamberti*, 545 F.2d 747, 192 USPQ 278, 280 (CCPA 1976); *In re Simon*, 59 CCPA 1140, 461 F.2d 1387, 174 USPQ 114 (1972); and *In re Mills*, 470 F.2d 649, 176 USPQ 196 (CCPA 1972). *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1068, 44 USPQ2d 1336, 1339 (Fed. Cir. 1997) (error to construe prior art disclosure as limited to the preferred embodiment). MPEP §2123.

## Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

**Examiner Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*S*  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
June 12, 2005